

Remarks

Claims 1, 8, 11, 12, 14, 15, and 19-161 are pending in the instant application following entry of the foregoing amendments. Claims 2-7, 9-10, 13, and 16-18 have been canceled without prejudice or disclaimer. Applicants reserve the right to file one or more divisional applications directed to the subject matter of the canceled claims.

Applicants respectfully request reconsideration and withdrawal of the present restriction requirement.

The Restriction Requirement

The Examiner has required restriction of the claims into one of eight different groups. In addition, in the event that Group III or Group VIII is elected, the Examiner has further required an election of species. *See*, Paper No.3, pages 4-5.

In accordance with 37 C.F.R. § 1.143, Applicants hereby provisionally elect *with traverse* Group III, Species B, represented by claims 19-43, as set out by the Examiner. Applicants reserve the right to file one or more divisional applications directed to the non-elected inventions should the restriction requirement be made final.

Applicants respectfully traverse and request the withdrawal of the requirement for restriction.

The Examiner contends that inventions of Groups I-VIII are distinct. However, Applicants respectfully point out that, even where two patentably distinct inventions appear in a single application, restriction requirement remains improper unless it can be shown that the search and examination of both inventions would entail a "serious burden" (*see*, M.P.E.P. § 803). In the present situation, no such showing has been made. Indeed, no arguments have been made explaining why it would impose an undue burden to examine Groups I-VIII together.

Applicants submit that a search of the polynucleotide claims would provide useful information for the polypeptides and methods of making and using the same. This is because the evolution of one is tied to the existence of the other. Moreover, in many if not most publications, where a published polynucleotide is shown, the authors also include the polypeptides and methods of making and using the same. Thus, the searches for polynucleotides, polypeptides, and methods of making and using would be overlapping.

Similarly, a search of the polypeptide claims of the invention would clearly provide useful information for the examination of claims directed to antibodies either produced in response to or having affinity for the subject polypeptides. This is because antibodies are frequently defined by the antigens that they are produced in response to and the epitopes to which they bind. Moreover, in many publications where an antibody is described, the corresponding antigen is also described. Accordingly, as applied to Groups I-VIII, the restriction requirement should be withdrawn.

Additionally, in the event that Group III or Group VIII is elected, the Examiner has further required an election of species. The Examiner contends that claims 10, 19-43, 53-79, 89-115, and 125-152 of Group III and claims 44-52, 80-88, 116-124, and 153-161 of Group VIII "are generic to a plurality of disclosed patentably distinct species." *See*, Paper No.3, pages 4-5, paragraph nos.6 and 7, respectively. While the Examiner has required election of a single species if either Group III or Group VIII is provisionally elected, Applicants respectfully point out that in the event a generic or linking claim is allowable, then the non-elected species will be subject to rejoinder and examination for patentability in the instant application. *See* M.P.E.P. § 809.02(c) and 809.04.

In order to be fully responsive, Applicants hereby elect, with traverse, Group III, Species B, represented by claims 19-43. Applicants reserve the right to file one or more divisional applications directed to non-elected inventions should the restriction requirement be made final. In such a case, Applicants retain the right to petition from the final restriction requirement under 37 C.F.R. § 1.144.

Conclusion

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Dated: 26 April 2002

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Yu et al.
Application Serial No.: 09/988,292
Filed: November 19, 2001
Title: Colon Specific Genes and Proteins

Attorney Docket No.: PF160D2
Art Unit: 1637
Examiner: Tung, J.

TECH CENTER 1600/2900

MAY 03 2002

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

Text has been amended as indicated by brackets [] (for deletions)
and underlining (for additions).

In the Specification:

At page 1, after the title:

Cross Reference to Related Applications

This application is a divisional of U.S. Application Serial No. 09/224,110, filed March 31, 1998, now issued as U.S. Patent No. 6,337,195, which is a divisional of U.S. Application Serial No. 08/469,667, filed June 6, 1995, now issued as U.S. Patent No. 5,733,748, each of which the present application claims priority to under 35 U.S.C. § 120 and each of which is hereby incorporated by reference in its entirety.